



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Handwritten initials

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,690	01/09/2001	Orville G. Kolterman	030639.0066.UTL	4666
28381	7590	06/06/2005	EXAMINER	
ARNOLD & PORTER LLP ATTN: IP DOCKETING DEPT. 555 TWELFTH STREET, N.W. WASHINGTON, DC 20004-1206			JIANG, DONG	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,690

Applicant(s)

KOLTERMAN ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 24-41 is/are pending in the application.
4a) Of the above claim(s) 16-18 and 38-40 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15, 24-37 and 41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-18 and 24-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED OFFICE ACTION

Applicant's response filed on 14 March 2005 is acknowledged.

Currently, claims 1-18 and 24-41 are pending, and claims 1-15, 24-37 and 41 are under consideration.

Note: applicants indicate that claims 21-23 were previously withdrawn from consideration, which is incorrect as claims 21-23 were canceled by applicants in the response filed on 19 March 2004.

Withdrawal of Objections and Rejections:

The scope of enablement rejection of claims 1-15, 24-37 and 41 under 35 U.S.C. 112, first paragraph, made in the last Office Action mailed on 17 November 2004 is withdrawn in view of applicant's argument.

Rejections Over Prior Art:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1646

Claims 1-14, 24-36 and 41 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Karpe et al. (Metabolism, 1999, 48:301-307), and in view of Beeley et al. (WO 98/30231), and Beers et al. (the Merck Manual, 1999, 17th edition, pages 200 and 2550), for the reasons set forth in the last Office Action mailed on 17 November 2004 at pages 4-5.

Applicants argument, filed on 14 March 2005 has been fully considered, but is not deemed persuasive for reasons below.

At page 7 of the response, the applicant argues that the present claims relate to the lowering of triglyceride levels in a patient identified with elevated triglyceride levels using exendin, that Beeley does not discuss the use of exendin in reduction of triglycerides specifically, and the discussions of lowering of plasma lipids in Beeley are in the context of a reduction in food intake, and that the reference does not teach or suggest the identification of a subject having elevated postprandial triglyceride levels and ability of exendins to specifically lower triglycerides in spite of constant food intake. This argument is not persuasive for the following reasons. First, if the Beeley reference had taught or suggested those limitations, it would have anticipated the present claims, and been used in a rejection under 35 U.S.C. 102. Further, besides discussing lowering of plasma lipids in the context of a reduction in food intake, Beeley also teaches that an exendin or an agonist thereof can be used for conditions or disorders such as obesity, diabetes, eating disorder, and insulin-resistance syndrome, for *lowering plasma lipids*, and for reducing the cardiac risk (page 10, lines 4-19). Several those conditions are associated with elevated triglyceride levels, for example, diabetes. With respect to the specific limitation of “lowering triglyceride levels” in the present claims, given the fact that, according to Beers, triglyceride is one of the two *major* types of plasma lipids (cholesterol and triglyceride; LDL and HDL are subtypes of total cholesterol), Beeley’s “plasma lipids” would inevitably include triglyceride, and therefore, it would be obvious to a person having ordinary skill in the art to treat a patient having elevated triglyceride levels with exendin. Furthermore, Karpe teaches a close link between the elevation of plasma triglycerides, especially the postprandial level, and coronary heart disease (CHD), which makes it instantly clear that lowering triglyceride levels would be needed in these individuals identified to have elevated postprandial triglyceride levels in order to reduce the risk of CHD. Karpe’s population of patients is the same as that of the instant invention. As such, applicants have not established a patient population being treated,

Art Unit: 1646

which is distinct from that suggested by either Beeley or Karpe. As the *combined* teachings by Karpe and Beeley teaches the a method that comprises applying the same active ingredient to the same patient population for the same purpose, and the same method steps as that of the instant invention, the present claims are obvious over the cited prior art.

At pages 7-8 of the response, applicants, citing case law, further argue that “obviousness cannot be predicated on what is unknown”, “both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant’s disclosure”, and “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed inventions, would have selected these compounds for combination in the manner claimed”; that Beeley does not teach or suggest the identification of a subject with elevated postprandial triglyceride levels, followed by the administration of exendin; and that the examiner has not shown by objective evidence that one skilled in the art would reasonably expect the method of Beeley to reduce the postprandial triglyceride levels absent the reduction of food intake. This argument is not persuasive for the following reasons. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, it is the combined references that made the instant invention obvious as they teach that the postprandial elevation of plasma triglycerides is more closely linked to CHD (by Karpe), indicating the need of lowering triglyceride levels in these individuals, and exendin can lower plasma lipids (by Beeley), which encompass mainly cholesterol and triglyceride (by Beers). As such, it becomes instantly obvious from the teachings of the prior art (nothing from applicants disclosure) that exendin can be used in patients having elevated postprandial triglyceride levels, and that a result as that confirmed by applicants is both inherent and expected.

Art Unit: 1646

Applicants further argue, at page 8 of the response, that as Karpe does not teach a method for lowering triglyceride levels with an exendin, the reference does not remedy the deficiencies of Beeley and Beers, and that the cited references taken in combination do not teach or suggest the claimed invention. This argument is not persuasive for the reasons addressed above.

Claims 15 and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Karpe et al. (Metabolism, 1999, 48:301-307), Beeley et al. (WO 98/30231), and Beers et al. (the Merck Manual, 1999, 17th edition, pages 200 and 2550), as applied to claims 1-14, 24-36 and 41 above, and further in view of Wagle et al., US 6,326,396 B1, for the reasons set forth in the last Office Action mailed on 17 November 2004 at pages 5-6.

Applicants argument, filed on 14 March 2005 has been fully considered, but is not deemed persuasive for reasons below.

At page 8 of the response, the applicant argues that Wagle does not recognize the ability of exendins to lower postprandial plasma triglycerides as an independent mode of action, and thus does not remedy the deficiencies of Karpe, Beeley and Beers. This argument is not persuasive for the same reasons above, and because, as addressed in the last Office Action, the point to learn from Wagle is that HMG-CoA reductase inhibitors or statins are agents acting directly on plasma triglyceride and cholesterol content, and are effective in lowering triglyceride and cholesterol content, and that lowering of circulating lipids has been to reduce the cardiovascular morbidity. Therefore, it is prima facie obvious to combine exendin and statins for lowering plasma triglyceride as both are known to be used for the very same purpose.

Conclusion:

No claim is allowed.

Art Unit: 1646

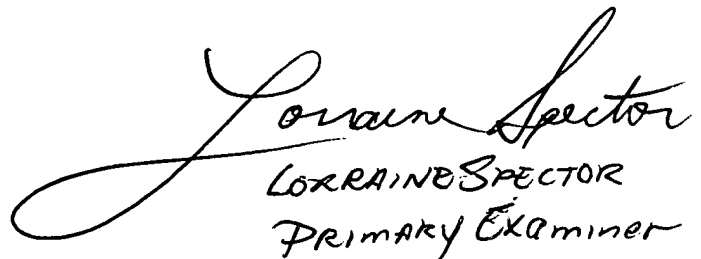
Advisory Information:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on 571-272-0829. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


LORRAINE SPECTOR
PRIMARY EXAMINER

Dong Jiang, Ph.D.
Patent Examiner
AU1646
5/18/05